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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/463,096      | 04/12/2000  | HANS TANDLER         | GK-ZEI-3078         | 5855             |

26418 7590 12/03/2003

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|          |
|----------|
| EXAMINER |
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FINEMAN, LEE A

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2872

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/463,096

Applicant(s)

TANDLER ET AL.

Examiner

Lee Fineman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-15 and 17-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 Apr 2000 and 11 Sept 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 9 September 2003 and 11 September 2003 have been entered in which claim 13 was amended. Claims 13-15 and 17-23 are pending.

### *Drawings*

2. Replacement drawings were received on 11 September 2003. These drawings are acceptable.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13-15, 17-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figure 1 of the instant application which is admitted prior art (Admission) in view of Nagashima et al., U.S. Patent No. 5,742,135<sup>4</sup> and Sarfaty et al., U.S. Patent No. 5,741,171.

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Regarding claims 13, 17 and 23, Admission discloses a stereomicroscope with a zoom system (fig. 1) comprising a drive motor (M) driving at least one moving lens system (L1 or L2). Admission lacks linear direct driving motors being controlled by a control unit which reads calculated pre-stored values of reference points from a mathematical controlling curve for directing the movement of the at least one moving lens system by controlling the driving motors in a corresponding manner without necessitating use of mechanical generation of the mathematical controlling curve; and the control unit being used for motorized zoom adjustments and motorized focusing of the microscope. Nagashima et al. teaches a zoom system with a driving means (9 and 10) being controlled by a control unit (6) which reads calculated pre-stored values of reference points from a mathematical controlling curve for directing the movement of the at least one moving lens system (2 or 3) by controlling the driving means in a corresponding manner without necessitating use of mechanical generation of the mathematical controlling curve (column 3, lines 13-24) and the control unit being used for motorized zoom adjustment and for motorized focusing (column 3, lines 13-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the drive unit of Admission with a drive unit of Nagashima et al. to be able to maintain an in-focus image during zooming (column 2, lines 6-9; Nagashima).

Nagashima et al. discloses driving means to linearly move the lens groups. This arrangement appears to be direct linear drive motors. However in as much as direct linear drive motors are not explicitly disclosed, use of such motors are well know in the art for zoom systems. For example, Sarfaty et al. teaches a video microscope and video imager with zooming (column 2, lines 60-64) wherein direct linear driving motors are used (stepper motors, column 9,

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lines 35-36). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use well known direct linear drive motors to provide precise linear movement of the lens groups.

Regarding claim 15 and 20, Admission in view of Nagashima et al. discloses lens members that comprise at least one moving lens system (L1 or L2) and are provided as lens pairs in a Greenough type stereomicroscope or telescope type stereomicroscope (Admission, fig 1) and plurality of moving lens members (L1 and L2) that comprise of at least one moving lens system and are controlled jointly (Admission, fig. 1).

Regarding claims 18 and 19, Admission in view of Nagashima et al. discloses the claimed invention but is silent to the linear drives being arranged in the stereomicroscope housing and between the lens pairs. Official Notice is taken that having linear drives being arranged in a device housing is well known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the linear drives of Admission in view of Nagashima et al. be arranged in the stereomicroscope housing in order to protect against foreign particles, etc. which would interfere with the operation of the motors. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the driving motors of Admission in view of Nagashima et al. to be between the lens pairs, since it has been held that a mere rearrangement of an element without modification of the operation of the device involves only routine skill in the art. One would have been motivated to rearrange the driving motors to be between the lens pairs again for the purpose of making the overall device more compact. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

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Regarding claims 14 and 21, Admission further discloses two lens members (L1 and L2) that comprise at least one moving lens system (fig. 1). Admission discloses the claimed invention except for the two lens members being controlled independently from one another and driven separately. Nagashima teaches a zoom system wherein two lens members (2 and 3) are being controlled independently from one another and driven separately (through 9 and 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make each of the lens members of Admission be controlled and driven separately, as suggested by Nagashima to be able to maintain an in-focus image during zooming (column 2, lines 6-9; Nagashima).

5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Admission in view of Nagashima et al. as applied to claim 13 above, and further in view of Pensel et al, U.S. Patent No. 5,867,308.

Admission in view of Nagashima et al. discloses the claimed invention except for a linear magnification that is adjusted is determined and displayed during the controlling of the zoom system. Pensel et al. teaches a linear magnification that is adjusted is determined and displayed during the controlling of the zoom system (12, fig. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the linear magnification of Admission in view of Nagashima et al. that is adjusted be determined and displayed as Pensel et al. suggests in order to arrive at a desired magnification with ease.

*Response to Arguments*

6. Applicant's arguments filed 9 September 2003 have been fully considered but they are not persuasive.

Applicant "seasonably challenged" the Official Notice statement that direct drive linear motors are well known. The examiner has provided the Sarfaty et al. reference as evidence of this teaching.

Applicant argues that the drive motors of Nagashima et al. are not accurate enough to be used in a stereomicroscope. It is noted that the features upon which applicant relies (i.e., degree of accuracy of the motors) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Nagashima et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the applicant is concerned with motor-operated moving optical elements, zoom or focusing systems and Nagashima clearly is a motor-operated zoom system. Further the applicant states "why would someone in the stereomicroscope art look to the video camera art..." and that there is no suggestion to combine the references. The examiner would like to point out that the applicants own disclosure includes examples of zoom systems in the camera and video camera art (page 2, U.S. Patents 5,258,798 and 5,365,296) and argues that knowledge that a motorized zooming systems may be in many

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different optical systems including microscopes or cameras is generally available to one of ordinary skill in the art.

7. It is noted by the Examiner that the 112 rejection made in the previous Office Action have been withdrawn due to amendment by the Applicant.

8. It is noted as directed by the MPEP 2144.03 that if the applicant does not seasonably traverse the well-known statement during examination, then the object of the well-known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). As such, the official notice statement of the examiner about housings is now held to be admitted prior art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (703) 305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9318.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



LAF  
November 24, 2003

  
MARK A. ROBINSON  
PRIMARY EXAMINER